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8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
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11 FINJAN, INC.,

12 Plaintiff,

13 v.

14 ESET, LLC and ESET SPOL. S.R.O.,

15 Defendants.  
16

Case No.: 17CV183 CAB (BGS)

**ORDER ON DISCOVERY DISPUTE  
REGARDING INTERROGATORY  
NO. 6**

[ECF 215]  
17

18 Plaintiff Finjan, Inc. (“Finjan”) seeks to compel further responses to Finjan’s  
19 Interrogatory No. 6 (“ROG 6”) which seeks ESET, LLC and ESET spol. S.R.O.’s  
20 (“ESET”) noninfringement contentions. (Joint Statement on Discovery Issue Relating to  
21 ESETs Response to Finjan’s Interrogatory No. 6, ECF 215 at 1-3<sup>1</sup>.) ESET opposes  
22 providing any further response. (*Id.* at 4-6.) For the reasons set forth below, Finjan’s  
23 request is **GRANTED in part and DENIED in part.**  
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27 <sup>1</sup> The Court references the CM/ECF pagination. ECF 215 corresponds to the parties’  
28 Joint Statement and ECF 215-1 corresponds to Exhibit A, ESET’s Response to Plaintiff’s  
Second Set of Interrogatories.

1 **I. BACKGROUND**

2 ROG 6 states:

3 Separately for each Asserted Claim of the Asserted Patents, identify all legal  
4 and factual bases for your contention that ESET does not infringe such claim,  
5 including a chart that identifies each claim element that ESET contends is not  
6 satisfied by the Accused Instrumentality(ies) for that claim, and a substantive,  
7 particularized description of how and why that element is not satisfied,  
8 including citation to specific components and functions of the Accused  
Instrumentality(ies) and all documents and things in support of your position,  
including source code modules.

9 (ECF No. 215-1 at 8.)

10 ESET responded without waiving its general and specific objections. (ECF No.  
11 215-1 at 8.) As to each patent-in-suit it provided a chart which listed in italics the  
12 limitations the accused instrumentalities do not infringe. (*Id.* at 10-20.) As to some of  
13 the patents-in-suit ESET also provided a brief explanation as to how the products do not  
14 infringe the asserted claims. For example, “it does not practice the claimed methods”  
15 (ECF 215-1 at 11, 15); “its products only function downstream of the web server” (*id.* at  
16 11); “[it] does not provide ‘memory storing a first rule set’” (*id.*); “it does not provide the  
17 ‘network interface’ component of the system” (*id.* at 14); “its products do not modify  
18 Downloadables to append any information to the end of the Downloadable, nor do any of  
19 the products generate a Downloadable Security Profile” (*id.* at 16); “it does not supply at  
20 least the ‘processor,’ ‘memory,’ ‘operating system probes,’ or ‘interrupter.” (*Id.* at 18.)

21 **II. DISCUSSION**

22 Finjan argues that ESET’s response is insufficient. As to ESET’s chart, Finjan  
23 seeks explanation why any element is not met since Finjan’s infringement contentions  
24 explain how that element is in fact met. (ECF No. 215 at 2.) Finjan cites to various  
25 districts’ local patent rules and decisions applying them that require detailed explanations  
26 in support of noninfringement contentions. (*Id.* at 3 nn. 1-4.) As to the additional  
27 descriptions ESET set forth as to some of the patents-in-suit, (detailed above), Finjan  
28 complains that ESET does not tie these short descriptions to claim elements nor does

1 ESET provide any support for its position. (*Id.*) Finjan claims prejudice for this  
2 conclusory response in that it is not on fair notice of ESET’s noninfringement  
3 contentions, and it cannot focus its discovery efforts and develop its case. (*Id.* at 4.)

4 ESET argues the ROG goes beyond the permitted 25 interrogatories, is premature,  
5 and overly burdensome. (ECF No. 215 at 5.) Further, it asserts that its response is  
6 sufficient, identifying the specific elements missing from the claims, and has explained  
7 why those elements are missing. (*Id.*) ESET contends it cannot prove a negative. (*Id.* at  
8 It is not possible for it to identify specific source code and documents to prove what  
9 ESET’s code does not do. (*Id.* at 7.)

#### 10 **A. Legal Standards**

11 In general, the Federal Rules of Civil Procedure provide that “parties may obtain  
12 discovery regarding any non-privileged matter that is relevant to any party’s claim or  
13 defense and proportional to the needs of the case.” Fed. R. Civ. P. 26(b)(1). District  
14 courts have broad discretion in determining what is relevant regarding discovery.  
15 *Facedouble, Inc. v. Face.com*, No. 12cv1584 DMS (MDD), 2014 WL 585868, at \*1  
16 (S.D. Cal. Feb. 13, 2014). Limits on discovery may be issued where the “burden or  
17 expense outweighs the likely benefits.” *Id.* (citing Fed. R. Civ. P. 26(b)).

18 “An interrogatory may relate to any matter that may be inquired into under Rule  
19 26(b).” Fed. R. Civ. P. 33(a)(2). Furthermore, “[e]ach interrogatory must, to the extent it  
20 is not objected to, be answered separately and fully in writing under oath.” Rule  
21 33(b)(3). In certain circumstances the responding party has the option to answer the  
22 interrogatory by specifying responsive records and making those available to the  
23 interrogating party. Rule 33(d).

24 Contention interrogatories are distinct from interrogatories seeking the  
25 identification of witnesses or documents related to allegations. *In re Grand Casinos Inc.*  
26 *Sec. Litig.*, 181 F.R.D. 615, 618 (D. Minn. 1998). Contention interrogatories may ask  
27 another party to state all the facts on which it bases its contentions. *Id.* Further, a  
28 contention interrogatory is appropriate during the early phases of discovery where

1 answering them would “‘contribute meaningfully’ to (1) clarifying the issues of the case;  
2 (2) narrowing the scope of the dispute; (3) setting up early settlement discussion; or (4)  
3 exposing a substantial basis for a motion under Rule 11 or Rule 56.” *HTC Corp. v. Tech.*  
4 *Props. Ltd.*, No. C08-00882, 2011 WL 97787, at \*2 (N.D. Cal. Jan. 12, 2011) (quoting *In*  
5 *re Convergent Techs. Sec.Litig.*, 108 F.R.D. 328, 338-39 (N.D. Cal. 1985)). “A non-  
6 infringement contention interrogatory is appropriate where plaintiff has provided its  
7 infringement contentions with corresponding claim charts, thereby allowing defendant to  
8 respond.” *Audatex N. Am. Inc. v. Mitchell Int’l, Inc.*, No. 13cv1523 BEN (BLM), 2014  
9 WL 4961437, at \*3 (S.D. Cal. Oct. 3, 2014); *see also Facedouble, Inc.* 2014 WL 585868,  
10 at \*2.

## 11 **B. Analysis**

### 12 **1. Waiver of Objections**

13 In its response to ROG 6, ESET objected generally and specifically, alleging in  
14 part that it was premature and well beyond the twenty-five limit for interrogatories. (ECF  
15 No. 215-1 at 8-9.) However, ESET then responded “subject to and without waiving”  
16 these objections. (*Id.* at 9.) This language is typically referred to as a conditional  
17 response.

18 Written responses to requests for production of documents must be unconditional,  
19 and may not reserve the right to raise objections in the future. Language such as “without  
20 waiving objections” preserves nothing. *Consumer Elecs. Ass’n v. Compras and Buys*  
21 *Magazine, Inc.*, No. 08-21085-CIV, 2008 WL 4327253, at \*3 (S.D. Fla. Sept. 18, 2008).  
22 Objections preceding such language are deemed waived, and the response to the  
23 discovery request stands. *Estridge v. Target Corp.*, No. 11-61490-CIV, 2012 WL  
24 527051, at \*2 (S.D. Fla. Feb. 16, 2012). Notwithstanding, if the response puts the  
25 requesting party on notice that the responding party is withholding certain documents,  
26 that objection is preserved so long as the requesting party is not left guessing as to what  
27 documents are being withheld. *Sprint Commc’ns Co., v. Comcast Cable Commc’ns,*  
28 *LLC*, Nos 11-2684, 2685, 2686 –JWL, 2014 WL 1569963, at \*3 (D. Kan. April 18,

1 2014). In such a case the objection is not waived. Instead, the proper procedure is to  
2 challenge the objection by bringing a motion to compel and requiring the responding  
3 party to defend the merits of its response.

4 The Court finds that ESET's objections based on prematurity and excessive  
5 interrogatories waived. However, it finds ESET's response to ROG 6 has preserved its  
6 objections as to overly broad and unduly burdensome.

7 **2. Whether the Scope of Interrogatory 6 is Overly Broad and**  
8 **Burdensome; and Whether Supplemental Responses are Necessary**

9 As an initial matter, the Court notes that ROG 6 asks ESET to "identify *all*  
10 legal and factual bases," as well as citations to *all* documents and things in  
11 support" of its position. (ECF 215-1 at 8 (emphasis added).) The Court finds this  
12 request is overly broad and unduly burdensome. An interrogatory may reasonably  
13 ask for the material and principal facts which support a contention. However, to  
14 require all facts, applications of law, all documents and things "would too often  
15 require a laborious, time consuming analysis." *IBP, Inc. v. Mercantile Bank of*  
16 *Topeka*, 179 F.R.D. 316, 321 (D. Kan. 1998). The burden to answer then  
17 outweighs its benefit. *Id.* The request's excessively burdensome nature becomes  
18 especially clear when considering Finjan's stated purpose for asking it: to be given  
19 fair notice of ESET's noninfringement contentions and to be able to focus its  
20 discovery efforts. (ECF No. 215 at 4.) Satisfying these purposes does not  
21 however, require ESET to reply with the entire body of legal and factual evidence  
22 in its possession. Therefore, the Court narrows this interrogatory to require ESET  
23 to state the principal and material factual and legal bases for asserting its non-  
24 infringement contentions, including identifying the principal and material evidence  
25 upon which it relies. *See e.g. High Point SARL v. Sprint Nextel Corp.*, No. 09-  
26 2269, 2011 WL 197875, at \*2 (D. Kan. Jan. 20, 2011) (citing *Anderson v. UPS,*  
27 *Inc.*, No. 09-2526, 2010 WL 4822564, at \*6 (D. Kan. Nov. 22, 2010)).

1 Applying this narrower interrogatory to ESET’s response to ROG 6, the  
2 Court find ESET needs to supplement its response. ESET’s chart lists the elements  
3 missing from the accused instrumentalities without further explanation as to how  
4 they do not infringe the particular element. Various jurisdictions have found that a  
5 “recit[ation of the] various claim terms and . . . unexplained denials of  
6 infringement” is not a sufficient response to a non-infringement contention. *G.*  
7 *Vincent, Ltd. v. Dux Area, Inc.*, No. C09-383, 2009 WL 5125387, at \*1 (W.D.  
8 Wash. Dec. 18, 2009); *see also Emcore Corp. v. Optimum Corp.*, No. 06-1202,  
9 2007 WL 852557, at \*2 (W.D. Pa. Mar. 16, 2007). The Court concurs with these  
10 courts, and finds that ESET’s merely listing the missing elements is not an  
11 adequate response.

12 ESET asserts that its chart explains why the elements are not present in the  
13 Accused Instrumentalities by listing the missing elements in italics. (ECF No. 215  
14 at 5.) ESET contends that Finjan’s request does not ask ESET to explain why any  
15 element is not met, based on Finjan’s infringement contentions. (*Id.* n.5.)

16 Interrogatory Number 6 states:

17 Separately for each Asserted Claim of the Asserted Patents, identify all legal  
18 and factual bases for your contention that ESET does not infringe such claim,  
19 including a chart that identifies each claim element that ESET contends is not  
20 satisfied by the Accused Instrumentality(ies) for that claim, and a substantive,  
21 particularized description of *how and why that element is not satisfied*,  
22 including citation to specific components and functions of the Accused  
Instrumentality(ies) and all documents and things in support of your position,  
including source code modules.

23 (ECF No. 215-1 at 8 (emphasis added).)

24 It is clear that ROG 6 is requesting ESET to answer “how” and “why” each  
25 element is not satisfied. And the Court’s narrowing of the interrogatory does not modify  
26 ESET’s obligation to respond accordingly.

27 ESET asserts that “Finjan’s contention interrogatory seeks the impossible by  
28 asking ESET to prove a negative.” (ECF No. 215 at 5.) ESET argues that Finjan is

1 seeking proof of “where in the ESET documents and source code the missing elements  
2 are not described.” (ECF No. 215 at 5.) Finjan argues it is not asking ESET to prove a  
3 negative, but rather to explain why any element is not met based on Finjan’s infringement  
4 contentions showing how that element is in fact met. (*Id.* at 4.) Accordingly, the Court  
5 finds that to the extent that Finjan has in fact shown how that element is met, ESET is to  
6 supplement its chart in accordance with this order by stating the principal and material  
7 factual and legal bases for asserting its non-infringement contentions, including  
8 identifying the principal and material evidence upon which it relies.

9 As regards source code, pursuant to *Audatex*, if a party seeks to support its non-  
10 infringement arguments with source code, it must “provide citations to the appropriate  
11 sections of the code.” *Audatex*, 2014 WL 4961437, at \*4. Such citations are used as a  
12 guide for the opposing party, and could be in the form of a narrative, index, or table of  
13 contents, etc. *Facedouble, Inc.* 2014 WL 585868, at \*2. Therefore, if any of ESET’s  
14 non-infringement arguments are supported by certain aspects of its source code, it must  
15 provide citations to the appropriate sections thereof. If, on the other hand, ESET does not  
16 intend to rely on its source code to argue noninfringement, it should so state in its  
17 supplemental response.

18 ESET also claims that it has satisfied Finjan’s request by incorporating Section 1.A  
19 of its Invalidity Contentions which provides explanations as to how it does not infringe.  
20 (ECF No. 215 at 6.) ESET also points to its particularized descriptions of how and why  
21 the elements are not satisfied.<sup>2</sup> (*Id.* at 5.) Finjan in turn argues that these purported  
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24 <sup>2</sup> ESET has asserted numerous reasons for non-infringement, including: invalidity (ECF  
25 No. 215-1 at 10, 12, 13, 14, 17, & 18); “it does not practice the claimed methods” (*id.* at  
26 11 & 15); “its products only function downstream of the web server” (*id.* at 11); “[it]  
27 does not provide ‘memory storing a first rule set’” (*id.*); “it does not provide the ‘network  
28 interface’ component of the system” (*id.* at 14); “its products do not modify  
Downloadables to append any information to the end of the Downloadable, nor do any of  
the products generate a Downloadable Security Profile” (*id.* at 16); “it does not supply at  
least the ‘processor,’ ‘memory,’ ‘operating system probes,’ or ‘interrupter’” (*id.* at 18.)

1 “descriptions” do no more than briefly state for certain patents (but not all) that its  
2 products do not perform certain functions without tying these statements to claim  
3 elements or providing any support. (*Id.* at 2.)

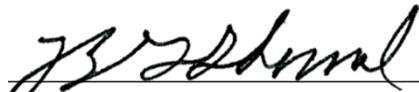
4 Pursuant to this Order, the Court makes no determination as to whether ESET’s  
5 incorporation of Section 1.A of its Invalidity Contentions as well as its particularized  
6 descriptions satisfactorily fill in the missing information in ESET’s chart. The Court  
7 concurs that “[i]t is not the role of the judge to state what constitutes specific reasons and  
8 relevant distinctions. Rather, it is my role to determine if [Defendant] has complied with  
9 the spirit of the rule.” *Emcore Corp. v. Optimum Corp.*, No. 06-1202, 2007 WL 852557,  
10 at \*2 (W.D. Pa. Mar. 16, 2007). ESET will have to supplement its chart so that it  
11 complies with this Court’s order.

12 **III. CONCLUSION**

13 Therefore, for the reasons stated above, the Court grants Finjan’s request in part,  
14 and orders ESET to supplement their response to Plaintiff’s Interrogatory Number 6 in  
15 accordance with this Order.

16 **IT IS SO ORDERED.**

17 Dated: March 23, 2018

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20 Hon. Bernard G. Skomal  
21 United States Magistrate Judge  
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